

REMARKS

In the Final Office Action mailed October 16, 2007, claims 1-29, 31-40, 42-49 and 55-59 were pending and stand rejected. In view of the following remarks, it is respectfully submitted that a prima facie case for rejecting the claims has not been established, and reconsideration and withdrawal of the final rejection of the claims are hereby requested.

Claims 1-8, 16-21, 26-29, 31, 36-40, 46-49 and 55-59 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,185,356 to Parker et al. The examiner asserts the traversal of the rejection of these claims over Parker et al. is not persuasive since the limitation "frictionally engageable with said inner wall surface, said frictional engagement sufficient to maintain a position of said lighting element relative to said retractor" only requires the lighting element to have the capability of being frictionally engageable with the inner wall surface of the retractor. It is respectfully submitted that the rejection of claims 1 and 16 is not proper since it ignores the limitation that the frictional engagement is sufficient to maintain a position of the lighting element relative to the retractor.

Claims 1 and 16 set forth an interrelationship between the retractor and the lighting element that serve to define an arrangement, relationship and organization of features not disclosed in Parker et al. It is further noted that MPEP §2173.05(g) states "[a] functional limitation must be evaluated and considered, just like any other limitation in the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." The MPEP goes on to further to refer to In re Venezia, 189 USPQ 149 (C.C.P.A. 1974) and recites "[i]n a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as 'members adapted to be positioned' and 'portions ... being resiliently dilatable whereby said housing may be slidably positioned' serve to precisely define structural attributes of interrelated component parts of the claimed assembly." Nowhere in Parker et al. is it disclosed that the lighting element includes a wall member that is positionable along the inner wall surface (claim 1) or bendable to conform to the inner wall surface (claim 16) and frictionally engageable in a manner where the frictional engagement is sufficient to maintain a position of the lighting element to the retractor. Parker et al. rely on a mechanical or adhesive connection to attach the light transmitting member to the accessory device, and there is no disclosure of any frictional engagement relationship that maintains the

positioning of the lighting element relative to the retractor. Therefore, a prima facie case for rejecting claims 1 and 16 as anticipated by Barker et al. has not been established, and withdrawal of the rejections is respectfully requested.

With respect to claims 26 and 36, the examiner asserts that the lighting element of Parker et al. is axially and circumferentially movable along the inner wall surface by means of attachment member 2850. Parker et al. disclose that "[a]ttachment member 2850 can take a variety of suitable forms, including adhesive tape, Velcro fasteners, clips, hooks, tabs, clamps, snaps and the like." See col. 18, lines 52-54. Furthermore, Parker et al. disclose that "protective cover 2850 [sic] may suitably include molded clips, hooks, tabs, or the like, for the attachment of an accessory." Considering that Parker et al. disclose that attachment member 2850 is a mechanical or adhesive connector for attaching the accessory device 2860 to the light transmitting member 2810 in a fixed position, it is submitted that there is no disclosure of an attachment member 2850 that allows the lighting element to move axially or circumferentially along a surface of accessory device 2860 while maintaining frictional engagement with the wall surface of accessory device 2860. Rather, Parker et al. disclose that the mechanical and adhesive connectors of attachment member 2850 fix the position of the light transmitting member 2810 relative to the accessory device, and the assertion that attachment member 2850 maintains frictional engagement with the wall surface of accessory device 2860 while permitting axial or circumferential movement of light transmitting member 2810 is not factually supported by the disclosure of Parker et al. Withdrawal of the rejection of claims 26 and 36 is respectfully requested.

Claim 46 also stands rejected as anticipated by Parker et al. Neither the Final Office Action nor any of the prior office actions provide any indication of how or where Parker et al. disclose the lighting element with the pair of wall members forming a concavely curved inner wall surface oriented toward and exposed to the working channel of the retractor and that is opposite a convexly curved outer wall surface. As discussed in the January 31, 2007 Response to Office Action, Parker et al. disclose a light transmitting member 2810 with a circular cross-section, which, as best seen in FIG. 28B, includes a convexly curved outer surface 2802 which extends about member 2810 and is exposed to the working channel provided by accessory device 2860. However, concavely curved inner surface 2804 is not exposed to the working channel.

Additionally, the embodiment of Figures 25A and 25B fails to disclose a concavely curved inner wall surface of the lighting element and further fails to disclose that any concavely curved inner wall surface of the lighting element is oriented toward and exposed to the working channel of the retractor. Withdrawal of the rejection of claim 46 is respectfully requested.

In addition to the patentability of the corresponding base claims, further reasons support patentability of rejected dependent claims. Claims 6, 19, 29 and 39 recite "wherein said inner wall surface of said retractor substantially encloses said working channel and said at least one wall member of said lighting element extends about at least 50 percent of said inner wall surface." Parker et al. do not disclose a retractor with an inner wall surface that substantially encloses the working channel. Rather, the retractors disclosed therein are not substantially enclosed by an inner surface to which a lighting element is engaged. Thus, these claims are allowable.

Claims 7, 20, and 40 recite "wherein said lighting element is movable axially along said inner wall surface while said at least one wall member maintains frictional engagement therewith" and claims 8, 21 and 31 recite "wherein said lighting element is movable circumferentially along said inner wall surface while said at least one wall member maintains frictional engagement therewith." As discussed above with respect to claims 26 and 36, Parker et al. disclose that attachment member 2850 is a mechanical or adhesive connector for attaching the accessory device 2860 to the light transmitting member 2810 in a fixed position, and it is submitted that there is no disclosure of an attachment member 2850 that allows the lighting element to move axially or circumferentially along a surface of accessory device 2860 while maintaining frictional engagement with the wall surface of accessory device 2860. Rather, Parker et al. disclose that the mechanical and adhesive connectors of attachment member 2850 fix the position of the light transmitting member 2810 relative to the accessory device, and the assertion that attachment member 2850 maintains frictional engagement with the wall surface of accessory device 2860 while permitting axial or circumferential movement of light transmitting member 2810 is not factually supported by the disclosure of Parker et al. Withdrawal of the rejection of claims 7-8, 20-21, 31 and 40 is respectfully requested.

Therefore, for at least these reasons, claims depending from rejected base claims 1, 16,

26, 36 and 46 that were rejected as anticipated by Parker et al. are allowable. Withdrawal of the rejection of these claims is respectfully requested.

Claims 1-2, 4-8, 16-21, 26-27, 29, 31, 36-37, 39-40, and 46 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,796,214 to Davis. The examiner maintains the traversal of the rejection over Davis is not persuasive since the limitation "frictionally engageable with said inner wall surface, said frictional engagement sufficient to maintain a position of said lighting element relative to said retractor" only requires the lighting element to have the capability of being frictionally engageable with the inner wall surface of the retractor. It is respectfully submitted that the rejection of claims 1 and 16 is not proper since, as is apparent by the examiner's admission, the limitation that the frictional engagement is sufficient to maintain a position of the lighting element relative to the retractor has not been considered.

Claims 1 and 16 set forth an interrelationship between the retractor and the lighting element that serve to define an arrangement, relationship and organization of features not disclosed in Davis. Davis merely discloses that a fiber optic bundle is carried in each of the tubular members. There is no disclosure of how the fibers in the bundle are arranged, or that a fiber in the bundle could be positioned against an inner surface of tubular member 50, 51 in frictional engagement therewith in a manner that is sufficient to maintain a position of another of the fibers in the bundle relative to the tubular member. Therefore, Davis also does not disclose all the features of claim 1.

Turning to independent claim 16, its features include a lighting element having at least one wall member and at least one light transmitting element along said at least one wall member, said at least one wall member being bendable to conform with the inner wall surface for frictional engagement therewith, the frictional engagement sufficient to maintain a position of the lighting element relative to the retractor. There is not disclosure in Davis that the fiber optic bundle is arranged with an optical fiber that is bendable to conform to the inner surface of tubular members 50, 51 or that any such optical fiber frictionally engages the tubular member 50, 51 to maintain a position of the fiber optic bundle in tubular member 50, 51. Davis therefore cannot anticipate claim 16.

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With regard to claims 26 and 36, the Final Office Action asserts that the fiber optic bundle is axially and circumferentially movable along the inner wall surfaces of members 50, 51. A review of Davis did not reveal any disclosure of these features, and the basis for the assertion is not clear. Davis would appear to disclose that the fiber optic bundle is fixed in members 50, 51 since each member 50, 51 includes a coupler 55 for operatively connecting the fiber optic bundle to a light conducting tube 56. If the fiber optic bundle were moved axially or circumferentially in members 50, 51, it is not clear how the fiber optic bundle could be operatively coupled to light conducting tube 56 since they would no longer be aligned at the end of members 50, 51 for such a connection. Therefore, Davis fails to disclose the features of claims 26 and 36.

With respect to claim 46, the Final Office Action asserts Davis discloses a coupler 55 including a pair of wall members or parts that are oriented toward the working channel of the retractor. Neither the Final Office Action nor any of the other office actions provide any indication of how Davis discloses "a lighting element including a pair of wall members and at least one light transmitting element between said pair of wall members, said pair of wall members forming a concavely curved inner wall surface of said lighting element and an opposite convexly curved outer wall surface of said lighting element, said outer wall surface positionable along said inner wall surface of said retractor with said inner wall surface of said lighting element oriented toward and exposed to said working channel." Therefore, since coupler 55 completely lacks any inner wall surface oriented toward and exposed to a working channel of the retractor, it cannot anticipate claim 46.

In addition to the patentability of the corresponding base claims, further reasons support patentability of rejected dependent claims. For example, claims 3, 18, 28, 38 "wherein said at least one wall member includes an inner wall member and an outer wall member, said plurality of light transmitting elements being positioned in a passage between said inner wall member and said outer wall member." Claims 3, 28 and 38 were not rejected by Davis, therefore it is not understood how Davis could be properly considered to disclose these same features recited in claim 18. Accordingly, Davis does not anticipate claim 18.

Claims 6, 19, 29 and 39 recite "wherein said inner wall surface of said retractor substantially encloses said working channel and said at least one wall member of said lighting

element extends about at least 50 percent of said inner wall surface." It is not clear how one fiber optic element of the fiber optic bundle in Davis would include these features relative to tubular members 50, 51, nor has the Final Office Action provided any basis for rejecting these claims. Thus, these claims are allowable.

Claims 7, 20, and 40 recite "wherein said lighting element is movable axially along said inner wall surface while said at least one wall member maintains frictional engagement therewith" and claims 8, 21 and 31 recite "wherein said lighting element is movable circumferentially along said inner wall surface while said at least one wall member maintains frictional engagement therewith." As discussed above with respect to claims 26 and 36, Davis would appear to disclose that the fiber optic bundle is fixed in members 50, 51 since each member 50, 51 includes a coupler 55 for operatively connecting the fiber optic bundle to a light conducting tube 56. If the fiber optic bundle were moved axially or circumferentially in members 50, 51, it is not clear how the fiber optic bundle could be operatively coupled to light conducting tube 56 since they would no longer be aligned at the end of members 50, 51 for such a connection. Therefore, Davis fails to disclose the features of claims 7-8, 20-21, 31 and 40.

Therefore, for at least these reasons, claims depending from rejected base claims 1, 16, 26, 36 and 46 that were rejected as anticipated by Davis are allowable. Withdrawal of the rejection of these claims is respectfully requested.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the '356 patent in view of U.S. Patent No. 3,807,393 to McDonald. Claim 4 depends from claim 1 and is allowable at least for the reasons claim 1 is allowable.

Claims 9-14, 22-24, 32-34, and 42-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parker et al. The Final Office Action asserts "Parker et al. clearly discloses that the lighting device can have a cross-sectional area of any shape. It is also noted that a person of ordinary skill in the art has good reason to choose from a finite number of available shapes, i.e. known options within his or her technical grasp, for providing a cover to a lighting element." The statement is not clear since the examiner asserts on the one hand that Parker et al. teach any cross-sectional area shape is suitable, and on the other hand asserts that there are a finite number of shapes from which one of ordinary skill in the art can choose. The examiner has not identified any teaching of the elements recited in these claims in the prior art, and has not

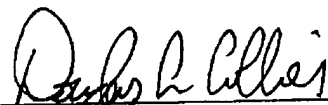
provided any rational reason why one of ordinary skill in the art would modify Parker et al. to arrive at claims 9-14, 22-24, 32-34 and 42-44. Furthermore, even if there is a finite number of shapes from which to choose, the examiner has not identified any prior art teaching of the elements arranged as recited in claims 9-14, 22-24, 32-34 and 42-44. It appears that the only teaching of these claims is in applicant's own specification, which is not a prior art reference. Accordingly, a prima facie case for rejecting claims 9-14, 22-24, 32-34 and 42-44 has not been established and withdrawal of the rejection of the same is respectfully requested.

Claims 15, 25, 35, and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Parker et al. in view of U.S. Patent No. 5,293,863 to Zhu et al. These claims depend from base claims that are allowable for the reasons provided above. Therefore, withdrawal of the rejection of these claims is respectfully requested.

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance with pending claims 1-29, 31-40, 42-49 and 55-59. Reconsideration of the present application as amended is respectfully requested. Timely action towards a Notice of Allowance is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted:

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